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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/709,288 | 04/27/2004 | Irene Spitsberg | 133323 | 3287 |
| 30952 | 7590 | 03/23/2006 | EXAMINER | |
| HARTMAN AND HARTMAN, P.C. 552 EAST 700 NORTH VAIPARAIISO, IN 46383 | | | | IVEY, ELIZABETH D |
| ART UNIT | | PAPER NUMBER | | |
| | | 1775 | | |

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/709,288 | SPITSBERG ET AL. |
| | Examiner Elizabeth Ivey | Art Unit 1775 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 July 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
 - 4a) Of the above claim(s) 18-40 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 April 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>27 April 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a protective coating, classified in class 428, subclass 688.
- II. Claims 18-40, drawn to a process of forming a protective coating, classified in class 427, subclass 453.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product may be made by a materially different process such as applying the coating to a mold, applying the silicon surface to the coating in the mold and lifting the silicon surface with the coating out of the mold.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gary Hartman on February 24, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-40 are

withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 10, 11-14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,410,148 B1 to Eaton, Jr. et al.

Regarding claims 1-4, Eaton '148 discloses a silicon –containing substrate with a coating of stoichiometric barium strontium aluminosilicate (BSAS) having 25 mole% BaO+SrO₂, where SrO₂ can be 0.1-0.90mole or .25-.75 25 mole% Al₂O₃, and 50 mole% SiO₂ (column 1 lines 55-60, column 2 lines 3-10, column 3 lines 10-25) and no indication of a non-stoichiometric material.

Regarding claim 10, Eaton'148 discloses the coating as including an intermediate layer of silica or mullite (column 3 lines 55-65).

Regarding claims 11-14 and 16, Eaton'148 discloses a surface with a coating including an intermediate layer of silica, mullite, mullite BSAS topped with a stoichiometric barium strontium aluminosilicate (BSAS) having 25 mole% BaO+SrO₂, where SrO₂ can be 0.1-0.90 mole or .25-.75, 25 mole% Al₂O₃, and 50 mole% SiO₂ (a celsian phase) and no indication of a non-stoichiometric material as deposited (column 1 lines 55-60, column 2 lines 3-10, column 3 lines 10-25 and 55-65).

Regarding claim 17, Eaton'148 discloses heat treating the product after formation (column 5 lines 9-17). A chemical composition and its properties are inseparable. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 MPEP 2112.01. Because the prior art exemplifies the applicant's claimed composition in relation to the substrate intermediate layer and coating, the claimed physical property relating to the porosity after heating is inherently present in the prior art. Absent an objective evidentiary showing to the contrary, the addition of the claimed physical property to the claim language fails to provide patentable distinction over the prior art.

Claims 1-4, 6, 8-10, 11-14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,254,935 B1 to Eaton et al.

Regarding claims 1 and 2, Eaton '935 discloses a silicon substrate with an intermediate layer, and with a thermal barrier layer of barium-strontium aluminosilicate (BSAS) (abstract, column 2 line 64-column 3 line 7 and column 3 lines 43-51). Eaton '935 discloses the barium strontium aluminosilicate comprises from 0.10-0.9 mole BaO, 0.10-0.9 mole SrO, 1.0 mole Al₂O₃ and 2 mole SiO₂ creating a stoichiometric composition of BSAS. The barrier layer being stoichiometric, no non-stoichiometric phase with sub stoichiometric silica is indicated.

Regarding claims 3-4, Eaton '935 discloses the composition indicated above for BSAS (from 0.10-0.9 mole BaO, 0.10-0.9 mole SrO, 1.0 mole Al₂O₃ and 2 mole SiO₂) allows for a thermal barrier upper layer coating having a composition with greater than or equal to 47 mole% silica with 25% mole% BaO+SrO, 25% Al₂O₃, 50% SiO₂ and SrO content of less than 25 molar% of the BaO+SrO content and having incidental impurities.

Regarding claims 6 and 8, Eaton '935 discloses all of the limitations of claim 1 and the following composition for BSAS: (from 0.10-0.9 mole BaO, 0.10-0.9 mole SrO, 1.0 mole Al₂O₃ and 2 mole SiO₂). This composition allows for a thermal barrier upper layer coating having a composition with 25% mole% BaO+SrO, 25% Al₂O₃, 50% SiO₂ and a SrO content of less than 25 molar% of the BaO+SrO content (column 2 line 64-column 3 line 7). Eaton '935 discloses one or more BSAS-containing layers, one of which may be a mullite-barium-strontium-aluminosilicate layer, as an intermediate layer or a second protective coating. This creates a thermal barrier with a lower non-stoichiometric mullite-barium-strontium-aluminosilicate phase.

Regarding claim 9, Eaton '935 discloses a barrier layer or outer protective layer of greater than or equal to 0.5 mils or 12.7 microns overlapping the range or 10-25 microns (column 3 lines 30-34).

Regarding claim 10, Eaton '935 discloses all of the limitations of claim 1 and discloses one or more intermediate layers between the substrate and the barium strontium aluminosilicate and discloses the layers may include SiO₂ or mullite layers (column 3 lines 38-45).

Regarding claims 11-14, 16 and 17, Eaton '935 discloses a silicon substrate with one or more intermediate barrier layers of SiO₂ or mullite, and with a thermal barrier layer of barium-strontium aluminosilicate (BSAS) (abstract, column 2 line 64-column 3 line 7 and column 3 lines 43-51). Eaton '935 discloses the intermediate Eaton '935 discloses the barium strontium aluminosilicate thermal barrier (upper) layer comprises from 0.10-0.9 mole BaO, 0.10-0.9 mole SrO, 1.0 mole Al₂O₃ and 2 mole SiO₂ creating a stoichiometric (at least 50% celsian) composition of BSAS (column 3 lines 20-24). This composition allows for a thermal barrier upper layer coating having a composition with 25% mole% BaO+SrO, 25% Al₂O₃, 50% SiO₂ and a SrO content of less than 25 molar% of the BaO+SrO content (column 2 line 64-column 3 line 7) The barrier layer being stoichiometric, no non-stoichiometric phase with sub stoichiometric silica or alumina phase is indicated. This is all in the as-deposited condition. Eaton '148 discloses heat treating the product after formation (column 5 lines 9-17). A chemical composition and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 MPEP 2112.01. Because the prior art exemplifies the applicant's claimed

composition in relation to the substrate intermediate layer and coating, the claimed physical property relating to the porosity after heating is inherently present in the prior art. Absent an objective evidentiary showing to the contrary, the addition of the claimed physical property to the claim language fails to provide patentable distinction over the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 6,254,935 B1 to Eaton et al. as applied to claims 1 and 11 above in view of U.S. Patent 6,352,790 B1 to Eaton et al.

Regarding claims 5 and 15, Eaton '935 discloses all of the limitations of claims 1 and 11 and the following composition for BSAS: (from 0.10-0.9 mole BaO, 0.10-0.9 mole SrO, 1.0 mole Al₂O₃ and 2 mole SiO₂). This composition allows for a thermal barrier upper layer coating having a composition with 25% mole% BaO+SrO, 25% Al₂O₃, 50% SiO₂ (column 2 line 64-column 3 line 7). Eaton '935 discloses one or more BSAS-containing layers, as an intermediate layer or a second protective coating for the purpose of providing advanced adhesion between the barrier layer and the substrate (column 3 lines 40-49). Although Eaton '935 does not disclose an alumina content greater than 25% or an alumina phase upto about 2%, Eaton '790 discloses an alumina enhanced BSAS coating with an Al₂O₃, additive upto 30% by weight that is capable of forming a reaction product with free silica and therefore capable of improving adhesion of the barrier coating with the substrate (column 3 lines 5-6 and 9-11). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use the alumina-enhanced BSAS-containg layer of Eaton'709 as the intermediate or second barrier layer of Eaton'935 to improve the adhesion of the surface barrier layer to the substrate. This alumina enhancement provides for an alumina content of the barrier coating of greater than 25%. Although Eaton'790 does not expressly disclose upto only 2% of the Al₂O₃ phase, it would have been obvious to a person having ordinary skill in the art at the time of the invention to adjust the Al₂O₃ phase within the disclosed range for the intended application, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have selected the overlapping portion of the ranges disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, In re Malagari, 182 USPQ 549.

Regarding claim 7, Eaton'935 discloses all of the limitations of claims 1 and 6 and discloses the lower or second barrier region layer, of a BSAS-containing intermediate layer is provided to enhance adhesion between the BSAS barrier layer and the SiO₂ substrate (column 3 lines 40-43). Although Eaton'935 does not disclose a second region of less than 47 mole% SiO₂, Eaton'790 discloses a barrier layer comprising a BSAS coating with an Al₂O₃, BaO.6 Al₂O₃, BaO. Al₂O₃, SrO.6 Al₂O₃ or SrO.Al₂O₃ additive that is capable of forming a reaction product with and therefore adhering to SiO₂ (column 2 lines 6-20). Because the substrate is SiO₂, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use the alumina enhanced coating of Eaton'790 as the lower barrier or an intermediate coating of Eaton'935 to enhance the adhesion between the substrate and the barrier layers. Eaton'790 discloses the additive may be present upto various weight percentages which would cause the SiO₂ to fall below 47 mol%, additionally, it would have been obvious to a person having ordinary skill in the art at the time of the invention to adjust the weight % additive for the intended application, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Ivey whose telephone number is (571) 272-8432. The examiner can normally be reached on 7:00- 4:30 M-Th and 7:00-3:30 alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elizabeth D. Ivey
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JM
JENNIFER MCNEIL
PRIMARY EXAMINER

3/19/06